

REMARKS / ARGUMENTS

This is meant to be a complete response to the Office Action mailed June 25, 2009. Claims 1, 3, 9, 11, 17 and 19 are herein amended to more clearly define the subject matter of Applicant's inventive concepts. Each of the Office Action rejections are discussed in detail herein below.

Claim Rejection(s) – 35 U.S.C. § 102(b)

In the Office Action, claims 1, 3-5, 8-9, 11-13, 16-17, 19-21 and 24 were rejected under 35 U.S.C. §102(b) as being anticipated by Garcia (U.S. Patent No. 6,088,429). In particular, the Action states that, with respect to Applicant's independent claims 1, 9 and 17, Garcia discloses a similar method for verifying prescriptions. At the outset, Applicant wishes to thank Examiner Ullah Masud for his review of the instant application in view of the prior art references. Although Applicant respectfully disagrees with the rejection of said claims as being anticipated by Garcia, independent claims 1, 9 and 17 have herein been amended to clarify the inventive concepts recited in the instant application. Applicant submits that Garcia does not anticipate or render obvious the subject matter recited in Applicant's independent claims, as amended. As such, Applicant respectfully requests reconsideration and withdrawal of the rejections to amended independent claims 1, 9 and 17, and also each claim which depends therefrom.

As the Examiner is aware, a claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently, in a single prior art reference. Garcia et al. does not disclose each and every element set forth in

independent claims 1, 9 and 17, as amended, and therefore each claim which depends therefrom.

In particular, Applicant's independent claims have been amended to clarify that the host system receives "a set of prescription information authorized by a health care provider from a computer system associated with the health care provider," rather than from a patient. Further, said claims have been amended to clarify that the set of prescription information and the unique identification code are then transmitted "to the computer system associated with the health care provider," rather than to the patient. Garcia does not teach or even suggest such features and instead specifically teaches away from such features. In fact, Garcia does not relate to Applicant's inventive concepts at all.

As background, drug diversion, fraud and errors are very large problems within the pharmaceutical industry. Medical or drug related errors are generally related to a lack of comprehensive patient information and history. These types of errors include excessive or redundant tests, services, prescription errors, missed diagnoses or false starts, as well as illness, hospitalization and death created by conflicting medications or illegible scripts. Drug fraud and diversion includes common schemes such as doctor shopping, pharmacy hopping, stolen, forged or altered scripts, and duplication of scripts, fraudulent "call-in" authorizations and unauthorized use of DEA or state license numbers.

The methods recited in independent claims 1, 9 and 17 address these issues, while Garcia's system does not. Instead, Garcia's system is directed to a system that provides medication related information to the patients via a telephony system and is not at all directed to a system that verifies prescriptions in an effort to prevent drug fraud and diversion.

Specifically, the problem which Garcia's system is meant to solve is the inherent problems associated with (1) verbal instructions from a pharmacist to a patient which are easily forgotten, and (2) written instructions from a pharmacist to a patient which are easily lost. (see col. 1, lines 10-15). In particular, Garcia's system is meant to provide:

a more comprehensive system for communicating important information relating to side effects, usage and general information for medications of every sort, independent of the specific manufacturer. There also remains a need for an interactive medication information system which provides immediate, on-demand answers to important questions of users at a level easily understood by the lay user and that is simple to use. (see col. 1, lines 30-38).

Thus, Garcia's system provides an automated telephony system that communicates with "the patient, or another individual acting on behalf of the patient," to provide information to the patient related to "(1) refill or renew prescription, (2) check on refill status, (3) get educational information about patient's (a) medications, (b) diagnosis information, (c) treatment plans, (d) patient's status." (see col. 2, lines 47-50 and col. 9, lines 24-29). Using a patient identifier, such as a social security number or a telephone number commonly known to family and friends, the patient can access Garcia's system to thereby obtain desired information and/or perform certain steps. Such a system would be understood to not relate to a system which verifies prescriptions in an effort to prevent drug fraud and diversion.

As previously submitted by Applicant, Garcia's system does not generate "a unique identification code...identifying the set of prescription information." In response, the Office Action directs Applicant's attention to column 13, lines 57-61, which recites:

Patient privacy can be protected. According to one embodiment of the invention, **the system provides an identification** that only the patient

or a family member would recognize as belonging to the patient (e.g., part of a social security number, birth date, or mother's maiden name). The person receiving the call must confirm the name of the patient for authentication. If the patient is at home, the system waits until the patient comes to the phone before speaking the reminder. (emphasis in Office Action).

Applicant is unclear how the cited section can be understood to teach or even suggest generating "a unique identification code...identifying the set of prescription information," when Garcia expressly states that the identification provided by Garcia's system only serves to identify the patient. Further, the cited section must be read in context with the particular embodiment of Garcia's system it is being used to describe. Beginning on line 40 of column 13, Garcia discusses use of his system as a telephonic appointment reminder system wherein the system automatically phones a patient with an upcoming appointment to verify whether the patient will be attending the scheduled appointment. The cited section is understood to address the instance wherein only the patient or family member will be provided information relating to the patient's appointment by using a identifier readily known to only the patient or family member. As understood, if a stranger were to answer the phone, the stranger would not understand Garcia's "identification" and would then be denied information relating to the patient and/or their scheduled appointment, thus preserving the patient's privacy. Thus, Applicant again submits that Garcia does not teach or even suggest the step of generating "a unique identification code...identifying the set of prescription information."

Further, Applicant submits that Garcia does not teach or even suggest the step of transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider," as recited in amended

independent claims 1, 9 and 17. The Office Action suggests that Garcia teaches the step of “transmitting the set of prescription information and the unique identification code” at, for example, column 9, lines 8-44. Therein, Garcia is understood to teach a system wherein a patient phones Garcia’s telephony system, the patient inputs a unique identifier, and Garcia’s system verifies the patient. Once verified, the patient can then select various functions options 218 including refilling or renewing a prescription, check on a refill status or the like. If the patient selects the refill function, Garcia’s system “posts the refill, renewal and status request to the pharmacy host system 224 and the results, if any, are returned to the caller, or provides the caller with educational information about the medication identified.” Thus, Garcia’s system specifically states that it transmits a patient’s prescription refill request directly to an external pharmacy. This is not the same as transmitting the set of prescription information and the unique identification code to the computer system associated with the health care provider, and then receiving the unique identification code from a computer system associated with the pharmacy, as recited in the pending claims.

In view of the above, Applicant respectfully submits that the Garcia reference does not teach or even suggest each of the features recited in the Applicant’s independent claims 1, 9 and 17, as amended, and therefore claims dependent therefrom. Thus, Garcia cannot properly serve as a basis for rejection under 35 U.S.C. §102(b). Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) of claims 1, 9 and 17, and therefore each claim which depends therefrom.

Claim Rejection(s) – 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 2, 6-7, 10, 14-15, 18 and 22-23 over various prior art references under 35 U.S.C. §103(a). In particular, claims 2, 7, 10, 15, 18 and 23 were rejected as being unpatentable over Garcia as applied to claims 1, 9 and 17 above, and further in view of Kobylevsky et al. (U.S. Pub. No. 2005/0060200). Claims 6, 14 and 22 were rejected as being unpatentable over Garcia as applied to claims 1, 4, 9, 12, 17 and 20 above, and further in view of Boyer et al. (U.S. Pat. No. 6,202,923). Applicant appreciates the Examiner's review of the pending application in view of the prior art references. However, Applicant believes that the prior art references, standing alone or in combination, do not disclose or otherwise render obvious the subject matter recited in independent claims 1, 9 and 17, as amended, and thus any of the claims which depend therefrom. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a).

For the reasons set forth above, and not repeated here for the sake of brevity, it is Applicant's belief that the Garcia reference fails to teach each and every element contained in Applicant's independent claims 1, 9 and 17, as amended, and therefore each claim which depends therefrom. Further, a careful review of Kobylevsky and Boyer reveals that they fail to correct the deficiencies noted in Garcia.

For example, Kobylevsky, similar to Garcia, is directed to a remote prescription refill system wherein "a central station remote from a pharmacy is provided for receiving phone calls...relating to prescription information. The central station obtains the prescription information, and *automatically* dispatches same to a pharmacy." See

Abstract. Although Kobylevsky does appear to permit a doctor to “record new prescriptions and/or refill authorizations” (See paragraph [0068]), the information flow is one-way, that is, from the patient or the doctor to the pharmacy. Kobylevsky does not teach any manner for the pharmacy to communicate with the doctor within their system. Therefore, Kobylevsky fails to provide for the deficiencies discussed in Garcia.

Boyer et al, on the other hand is offered for the proposition that it “discloses a method wherein the user is associated with an insurance company.” Granted, it is known in the art wherein a user, i.e., patient, is associated with an insurance company. However, Boyer et al. fails to disclose the steps required in Applicant’s independent claims 1, 9 and 17, and therefore each claim which depends therefrom, as recited above.

Instead, Boyer et al. is directed to an automated pharmacy system. Essentially, Boyer et al. teaches a method and system to be used in a pharmacy to reduce the chance of human errors when filling multiple prescriptions. Thus, Boyer et al. is not related to the prescription verification system at all. In particular, Boyer teaches an automated pharmacy to improve the workflow of medication dispensing and to reduce errors during the filling of prescriptions. Boyer’s automated pharmacy includes a data entry workstation for processing data relating to a prescription, a filling workstation for dispensing a drug type in a container, a checking workstation where a pharmacist checks and validates that the correct prescription has been dispensed, a counseling workstation for providing information to a customer, and a point-of-sale workstation for providing a prescription to a customer and receiving payment therefore. Boyer describes an in-house, single location, prescription dispensing system. Essentially, Boyer facilitates automated dispensing of drugs and the only “verification” that Applicant can locate in

Boyer (albeit a very important verification) is to make sure that the right pill gets in the right bottle for a given script. Boyer, however, does not appear to teach any manner of improving the flow of information between the doctor and the pharmacist. The prescriptions that Boyer fills are provided in either written form or call in form. See Col. 6, Ins. 5-13. Therefore, it is Applicant's belief that combining the teachings of Garcia with those of Kobylevsky et al. and/or Boyer et al. does not disclose or render obvious the novel aspects contained in the instant application, as recited in the pending amended claims.

In view of the argument set forth above, Applicant respectfully submits that independent claims 1, 9 and 17, as amended, and thus claims dependant therefrom are not anticipated or rendered obvious over the aforementioned prior art references, alone or in combination. Thus Applicant respectfully requests consideration and withdrawal of the rejection of claims 2, 6-7, 10, 14-15, 18 and 22-23 under 35 U.S.C. §103(a).

CONCLUSION

Applicant respectfully submits that this application is in condition for allowance for the reasons stated above. Therefore, it is requested that the Examiner reconsider each and every rejection as applicable to the claims now pending in the application and pass such claims to issue.

The foregoing is intended to be a complete response to the Office Action mailed June 25, 2009. In the event that any outstanding issues remain that would delay the allowance of this application, Applicant's attorney welcomes the opportunity to telephonically discuss such issues with the Examiner.

Respectfully submitted,

A handwritten signature in black ink, reading "Marc Brockhaus". The signature is written in a cursive, flowing style. The first name "Marc" is written in a larger, more prominent script, and "Brockhaus" follows in a similar but slightly smaller script. The signature is positioned above a horizontal line.

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